

REMARKS

The present application was filed on January 5, 2001 with claims 1-42. Applicants added new claims 43-50 in a previous response dated April 4, 2003. In the outstanding Office Action, the Examiner: (i) rejected claims 46 and 50 under 35 U.S.C. § 112, second paragraph, as being indefinite; (ii) rejected claims 1-5, 7-15, 17-26, 28-36, 38-42, 44, 46, 48 and 50 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,838,819 to Ruedisueli et al (hereinafter "Ruedisueli"); and (iii) rejected claims 6, 27, 43 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Ruedisueli in view of U.S. Patent No. 5,921,582 to Gusack (hereinafter "Gusack").

In this response, Applicants: (i) amend claims 46 and 50; (ii) traverse the various § 102 and § 103 rejections for at least the reasons given below; and (iii) cancel claims 43-50 without prejudice.

Regarding the § 112, second paragraph, rejection of claims 46 and 50, Applicants have canceled claims 43-50. Claims 43-50 represented independently rewritten forms of previously allowable claims 6, 12, 16, 21, 27, 33, 37 and 42, respectively. However, such allowability has apparently been withdrawn in the present Office Action. Accordingly, given the canceling of the claims, withdrawal of the § 112, second paragraph, rejection of claims 46 and 50 is respectfully requested. Likewise, given the canceling of claims 43-50, withdrawal of the § 102 and § 103 rejections of such claims is also respectfully requested.

Regarding the § 102(b) rejection of claims 1-5, 7-15, 17-26, 28-36 and 38-42, Applicants believe that said claims are patentable over Ruedisueli since Ruedisueli fails to teach or suggest all of the limitations of said claims.

By way of example, claim 1 recites a method of entering formatted electronic ink data provided in association with a user on a handwriting system which comprises, *inter alia*, the one or more pieces of writing medium being configured to have a predefined format including one or more fields associated with the predefined format . . . wherein a field comprises a delimited area of the writing medium, and the step of providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields. Claims 18, 22 and 39 provide similar limitations.

Ruedisueli discloses something significantly different. As first pointed out in Applicants' previous response dated April 4, 2003, while Ruedisueli relates to a technique for processing and managing electronic copies of handwritten notes in accordance with a handwriting system, Ruedisueli addresses the issue of maintaining synchrony between ink notes on a physical page and the virtual, electronic version of that page. That is, Ruedisueli discloses a technique for assigning writing "sessions" to specific pages, tracking of correct correspondences between the paper copies of notes and the electronic copies (see column 1, lines 38-52), and managing pages electronically stored (see column 1, lines 55-61). See also column 2, lines 10-19, where Ruedisueli states that "each session corresponds with a time period during which a collection of notes are made without being interrupted for the purpose of making a second collection of notes."

On the other hand, the claimed invention recites that the one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format wherein a field comprises a delimited area of the writing medium, and the step of providing one or more user-specified indications (e.g., one or more tags or some form of signaling) to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields, so as to permit a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields.

Advantageously, the claimed invention thus provides annotation of handwritten data for a variety of purposes, in which multiple user-specified indications (e.g., one or more tags or some form of signaling) can be made within a given session and/or page, or can be inserted at a later time. Such user-specified indications may be used to label data to a specific purpose, can have a variety of purposes, are not limited to handwritten entries, can be added at any time and are not restricted to be associated with a session associated to a specific page, can be entered in one session, and can be attached to the same set (or intersecting sets) of strokes.

As is evident, there is a significant difference between the claimed invention and Ruedisueli since Ruedisueli relates to a technique for overcoming the problem of associating virtual ink to the correct/corresponding page. On the other hand, the claimed invention employs fields (comprising delimited areas of the writing medium) and user-specified indications so as to permit a transition

between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields. This is neither the problem that Ruedisueli addresses nor the solution that Ruedisueli offers to solve its problem.

The present Office Action points to figures 2 and 3 of Ruedisueli where a user is shown entering an item 36 (i.e., page number 1) and an item 28 (i.e., a graph), respectively. The Office Action goes on to suggest that these items are being entered into a "delimited area" on the writing medium. However, as is clear from figures 2 and 3, the areas that the user is entering the page number and the graph are not delimited in any way on the writing medium. Thus, Ruedisueli does not teach or suggest that "one or more pieces of writing medium are configured to have a predefined format including one or more fields associated with the predefined format . . . wherein a field comprises a delimited area of the writing medium," as in the claimed invention.

The present Office Action also cites column 4, lines 5-16, of Ruedisueli and suggests that this teaches the claim limitation of permitting "a transition between the entry of electronic ink data in accordance with the one or more fields and entry of electronic ink data that is not associated with the one or more fields." However, column 4, line 5-16, merely state that a page number (item 36) may be used to manage the electronically captured pages in a natural manner. This is clearly a different concept than providing "a transition between the entry of electronic ink data in accordance with the one or more fields [in a delimited area of the writing medium] and entry of electronic ink data that is not associated with the one or more fields [in a delimited area of the writing medium]," as in the claimed invention.

Lastly, the present Office Action again cites figures 2 and 3 (and the page number referred to as item 36) of Ruedisueli in rejecting the claim limitation "providing one or more user-specified indications to indicate that electronic ink data entered in association with the one or more user-specified indications is to be associated with the one or more fields." However, it is not clear how this could teach or suggest the claim limitation. The Office Action states that "the user can see the ink as he writes on the paper associated with the page number." However, if the Examiner's argument is that the area that the user writes the page number on the paper is a "field," then how would the page number itself serve as a "user-specified indication . . . to indicate that electronic ink data entered in association with [the] user-specified indication is to be associated with the one or

more fields." This is not logical. The main reason is because Ruedisueli, as explained above, is not directed toward the same problems that the claimed invention addresses and therefore Ruedisueli does not teach or suggest the features recited in the claims.

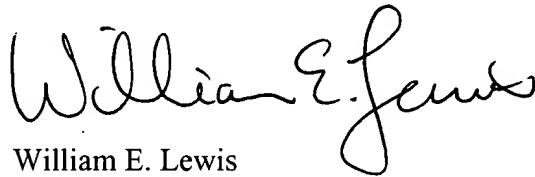
Furthermore, Applicants assert that the claims which depend from independent claims 1, 18, 22 and 39 are not only patentable over the cited reference in view of the above reasons, but also because such dependent claims recite patentable subject matter in their own right.

Further, since Gusack fails to remedy the deficiencies of Ruedisueli, Applicants assert that claims 6 and 27 are patentable over the cited combination.

Accordingly, withdrawal of the § 102(b) and § 103(a) rejections of the claims is respectfully requested.

In view of the above, Applicants believe that claims 1-42 are in condition for allowance, and respectfully request favorable reconsideration.

Respectfully submitted,

A handwritten signature in black ink, reading "William E. Lewis". The signature is written in a cursive, flowing style with a large, prominent "W" and "L".

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